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PATENT APPLICATION

RESPONSE UNDER 37 CFR §1.116
EXPEDITED PROCEDURE
TECHNOLOGY CENTER ART UNIT 2651

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5-6-04

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Akihiro HOSOKAWA et al.

Group Art Unit: 2651

Application No.: 09/836,201

Examiner: K. WONG

Filed: April 18, 2001

Docket No.: 109305

For: METHOD AND APPARATUS FOR ADJUSTING ANGULAR POSITION OF
MAGNETIC HEAD UNIT

REQUEST FOR RECONSIDERATION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RECEIVED

APR 27 2004

Technology Center 2600

Sir:

In reply to the February 6, 2004 Office Action, reconsideration is requested based on the following remarks.

Claims 1-13 are pending. Reconsideration in view of the following remarks is respectfully requested.

I. The Claims Define Patentable Subject Matter

Claims 1-13 are rejected under 35 U.S.C. §103(a) as unpatentable over U.S. Patent No. 6,057,975 to Yaeger et al. in view of U.S. Patent No. 5,728,240 to Yamamoto et al. This rejection is respectfully traversed.

Applicants respectfully submit that neither Yaeger nor Yamamoto, nor their combination teaches, discloses or suggests holding a flexible member with an angular

position modifying unit and applying a bend onto the flexible member using the angular position modifying unit for adjusting the angular position, as claimed in claim 1 and similarly claimed in claim 4.

Yaeger discloses an adjustment for fly height in magnetic storage systems. Figure 3 shows a laser beam 42 generated by laser 44 directed toward flexure arm 26. The flexure arm can be bent to a desired angle by selectively applying laser beam 42. Accordingly, flexure arm 26 can be heated such that slider 28 moves away from or toward the surface of disc 12. The effect of the laser is to heat a small area of the flexure arm 26 which causes the arm to bend due to localized thermal expansion.

The Office Action admits that Yaeger fails to mention a movable arm that holds the flexible member (magnetic head unit) or a holder for the flexible member. However, the Office Action asserts that Yamamoto makes up for this deficiency. Specifically, the Office Action asserts that Yamamoto discloses the teachings of a holder for the magnetic head unit (see column 13, lines 56-64 and Figure 3 of Yamamoto et al.). Accordingly, the Office Action asserts that it would have been obvious to modify the teachings in Yaeger with the magnetic head holder in Yamamoto as one would have been motivated to provide an external apparatus magnetic head adjustment.

The only suggestion for making the asserted combination lies in the present application. As such, the combination of Yaeger and Yamamoto was made using improper hindsight reconstruction of the references.

Specifically, each of Yaeger and Yamamoto are fully sufficient to accomplish their stated purposes. However, there is no advantage, and the Office Action has not asserted one, that would be obtained by modifying Yaeger to use a holding unit for the flexible arm. Yaeger discloses that it has been discovered that flexure arm 26 can be bent to a desired angle by selectively applying laser beam 42. The effect of the laser is to heat a small area of the

flexure arm 26 which causes the arm to bend due to localized thermal expansion. This provides a permanent bend.

The Examiner has the burden to establish a *prima facie* case of obviousness. To do this, the Examiner has to meet three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference when combined must teach or suggest all of the claim limitations. MPEP §2143. The mere fact that the references can be combined or modified does not render the result in combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F. 2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).


Thus, the combination of Yaeger and Yamamoto fails to disclose all of the subject matter of claims 1-13. Accordingly, the combination of Yaeger and Yamamoto fails to render obvious the subject matter of claims 1-13. Withdrawal of the rejection of claims 1-13 under 35 U.S.C. §103(a) is obvious in view of the combination of Yaeger and Yamamoto is respectfully solicited.

II. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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Date: April 23, 2004

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